

**REMARKS**

This relates to points made by the Examiner in the Advisory Action that was mailed on September 21, 2005 and in a telephonic communication on October 13, 2005. Claim 1 is rearranged somewhat, without the introduction of new matter, to emphasize an important feature of the present invention. A typographical error is corrected in claim 9. Claims 1-9 are pending in the application.

Applicants are grateful for Examiner Zimmer's comments in a telephonic communication on 13 October 2005. What follows is believed to be responsive to his comments.

In the Advisory Action, the Examiner questioned support for the express exclusion of certain flame retardant chemicals from the claims. The Examiner's attention is respectfully directed to lines 20-27 on page 2 of the specification.

***No prima facie obviousness***

Maeda discloses an epoxy resin composition for encapsulating semiconductors, which are free of halogen compounds and antimony compounds and are said to be excellent in flame retardancy, as in the inventive compound. In contrast, Shiobara indicates that "brominated epoxy resins are useful particularly when flame retardancy is required" (column 2, lines 33-34) and in the Examples that 10 parts of antimony trioxide (column 11, lines 5 to 6) and 7 parts of

brominated epoxy resin (TABLE 2) are blended. Manifestly, Maeda and Shiobara are concerned with two significantly different types of flame-retarded compositions.

The rejection is stated as follows: “Given the similarities between the inventions of Maeda and Shiobara, it would have been obvious to one having ordinary skill that the composition taught by Maeda could be improved with respect to crack resistance by adding a siloxane (co)polymer according to the teachings of Shiobara”. Applicants respectfully submit that it would be more accurate to say: “Given the fundamental dissimilarities between the inventions of Maeda and Shiobara with respect to their incorporation of various significant components or chemicals such as halogen compounds, antimony compounds, and brominated epoxy resins, it would not have been obvious to one having ordinary skill in the art that the antimony- and halogen-free composition taught by Maeda could be improved with respect to crack resistance by adding a siloxane (co)polymer to the brominated epoxy resins of Shiobara”. The Examiner’s statement of the rejection provides no rationale for ignoring the fundamental differences between the compositions of the two references. Accordingly, no motivation for combining Maeda with Shiobara has been established.

### ***Relevant comparisons***

Even if Maeda and Shiobara are combined, the present invention is still not expected therefrom. Applicants have provided a detailed explanation of the comparative data that is of record in the present application in the Amendment that was filed on September 6, 2005.

In the Advisory Action, the Examiner contends that “the composition suggested by the Examiner’s combination is the closest prior art”. Applicants are not required to compare the

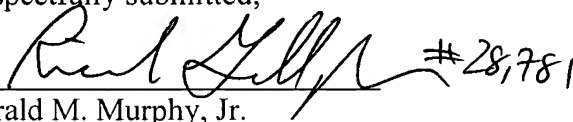
claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987). See also *In re Chapman*, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 “would be requiring comparison of the results of the invention with the results of the invention”. 148 USPQ at 714).

Should there be any remaining questions concerning the present application, Examiner Zimmer is respectfully requested to contact Richard Gallagher (Reg. No. 28, 781) at (703) 205-8008 in order to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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